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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,515	12/18/2001	William E. Weblar	ACS-60271 (2168P)	6307

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EXAMINER

LEUBECKER, JOHN P

ART UNIT PAPER NUMBER

3739

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/025,515

Applicant(s)

WEBLER ET AL.

Examiner

John P. Leubecker

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 10-16, 18 and 22-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 17 and 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/18/01 &amp; 6/16/03</u> | 6) <input type="checkbox"/> Other: _____  |

***Election/Restrictions***

1. Applicant's election without traverse of Group I, claims 1-22, in the reply filed on December 7, 2004 is acknowledged. Applicant's election without traverse of Species I, claims 1-9 and 17-22 is acknowledged. It is noted that although Applicant chose claims 18 and 22 as being readable on Species I, they appear to be readable on non-elected Species II (i.e., rotatable engagement). Therefore, the claims that will be examined will be claims 1-9, 17 and 19-21.

***Specification***

2. The abstract of the disclosure is objected to because of the phrases "The invention is directed to" (line 1), "The invention is further directed to" (line 6), and "The invention is also directed to" (line 9). Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, 8, 9, 17 and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Lafferty et al. (U.S. Pat. 5,188,093).

Lafferty et al. disclose an optical instrument having an optical connector (112) and a rotatable mechanical connector (96), and an optical guidewire comprising an elongated shaft

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(64,67), an optical pathway (space within distal end of elongated shaft (64) and open distal end) configured to pass optical radiation and an internal surface (inner surface of shaft 64) defining an internal chamber (space within proximal end of shaft 64 and hub 67), an elongated optical fiber (32) disposed at least in part within the internal chamber, and a ferrule (80,82,88,90) attached to the optical fiber and configured to friction fit (note connection of portions 82, 84 and 86, Fig.2, col.5, lines 33-38) with the elongated shaft hub (67), and configured to engage the optical connector to pass light therebetween (note optical connection of end 106 of optical fiber 32 to window 112, Fig.2, col.6, lines 3-5), the ferrule further configured to engage a rotatable connector (96, and specifically keys 94) effective that the ferrule rotates with the rotatable connector (96) when engaged to such (because the ferrule is securely attached to the connector 96, any rotation imparted on the connector 96 will impart rotation the ferrule). By the releasable friction connection of the ferrule with shaft hub (67), the ferrule is configured to have a position in which it can be freely rotated with disconnected from the shaft. It is note that combination of ferrule (80,82,88,90), optical fiber (32) and elongated shaft (64,67) can be considered as an “optical guidewire” as broadly as claimed.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lafferty et al. in view of Swanson et al. (U.S. Pat. 6,445,939).

Lafferty et al. discloses a diameter in the ferrule (specifically through portion 90) which accommodates the optical fiber 32. Although Lafferty et al. implies that the optical fiber (32) is on the order of several thousands of an inch (note distance d in Figure 3 is 20 thousands of an inch), there is no express mention of the diameter of the optical fiber. Swanson et al. evidences that an imaging optical fiber can be as small as 125 microns (0.005) (col.4, lines 16-47). Since Lafferty et al. never expressly mentions the optical fiber diameter (and thus the diameter of the ferrule portion that accommodates such), when reducing such device to practice, one of ordinary skill in the art would have considered it obvious at the time the invention was made to have “filled in the gaps” by using what is known in the art. Therefore, a optical fiber having a diameter as claimed in claims 6 and 7 would have been known and obvious to use. Thus, the diameter of the ferrule would have been substantially the same so as to accommodate this optical fiber (note Fig.2).

### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Due to the overly broad nature of the claims, only a portion of the relevant prior art found and deemed to read on at least some of the claims, will be cited below.

Lowery et al. (U.S. Pat. 4,624,243)

Hussein (U.S. Pat. 4,762,120)

Oneda et al. (U.S. Pat. 4,979,498)

Honda et al. (U.S. Pat. 5,152,277)

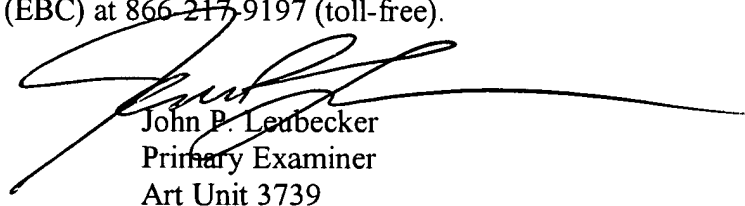
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Nakajima et al. (U.S. Pat. 5,330,067)	Kagan et al. (U.S. Pat. 5,396,880)
Kobayashi et al. (U.S. Pat. 5,407,443)	Segawa (U.S. Pat. 5,863,287)
Erdman et al. (U.S. Pat. 6,022,150)	Hamm (U.S. Pat. 6,263,133)
Ailinger et al. (U.S. Pat. 6,350,231)	Elbrecht et al. (U.S. Pat. 6,461,349)
Horii et al. (U.S. Pat. 6,687,010)	Neuberger et al. (US 2002/0064328)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
John P. Leubecker  
Primary Examiner  
Art Unit 3739

jpl